

REMARKS

Claims 7 and 16 are canceled without prejudice (since their features have been respectively included in claims 4, 5 and 11, 12, as explained below), and therefore claims 1 to 6, 8 to 15, 17 and 18 are now pending and being considered.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Claims 5 and 14 have been corrected grammatically. No new matter has been added. Approval and entry are respectfully requested.

With respect to page nine (9) of the Office Action, Applicants thank the Examiner for allowing claims 9 and 18, and for indicating that claims 6, 7, 8, 15, 16 and 17 contain allowable subject matter and would be allowed if rewritten to include the features of their respective base claims. As to the objections to claims, 6, 7, 8, 15, 16 and 17, to facilitate matters, claims 7 and 16 have been canceled without prejudice, claims 6 and 15 have been rewritten in independent form, and claims 8 and 17 have been rewritten to depend from allowable claims, as explained below. It is therefore respectfully requested that the objections be withdrawn.

With respect to paragraph I of the Final Office Action, claims 1, 4, 5, and 10 to 14 were rejected under 35 U.S.C. § 102(b) as anticipated by “Utsumi”, U.S. Patent No. 4,644,536.

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art

does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine must fail absent the foregoing conditions.

While the rejections may not be agreed with to facilitate matters, claims 1, 10, 11 and 12 have been rewritten.

Claims 11 and 12 have been rewritten to include the allowable features (as indicated by the Examiner) of claim 16, which has been canceled without prejudice. Accordingly, claims 11 and 12 are allowable.

Claim 1, as presented, is to a multiplexing and transmission apparatus which receives low-speed frame signals from a plurality of channels in parallel and outputs a high-speed serial signal, said multiplexing and transmission apparatus comprising: a control pulses generating circuit which generates control pulses each of which corresponds to one of said channels, wherein of said control pulses have different timing for each channel; channel-frame generating circuits, connected to said control pulses generating circuit, each of which receives said low-speed frame signal and outputs said low-speed frame signal in synchronization with said control pulse *so that an output timing of said low-speed frame signal is shifted with respect to an output timing of other low-speed frame signals so that a receiving side apparatus can recognize a channel number of said low-speed frame signal*; and a multiplexing circuit, connected to said channel-frame generating circuits, which multiplexes said low-speed frame signals into said high-speed serial signal and outputs said high-speed serial signal.

Claim 10 includes features like those of claim 1, as presented.

The "Utsumi" reference refers to a method of multiplexing digital signals, including the steps of: multiplexing serial digital signals of a plurality of channels which have a given transmission rate and each of which has frame synchronizing signals to a single serial signal, converting signals excluding the frame synchronizing signals of one selected channel to a format which allows inverse-conversion and which does not allow detection of the frame synchronizing signals, and using the frame synchronizing signals of said one selected channel as frame synchronizing signals of the single serial signal.

With respect to claims 1 and 10, the Final Office Action equates the control pulse, as provided for in the context of the claims, with the "clock pulse" in the "Utsumi" reference, but the "Utsumi" reference does not identically describe (or even suggest) that the control

pulses have different timing for each channel, as provided for in the context of the claimed subject matter.

In addition, the “Utsumi” reference does not identically describe (or even suggest) the feature of outputting “said low-speed frame signal in synchronization with said control pulse so that an output timing of said low-speed frame signal is shifted with respect to an output timing of other low-speed frame signals so that a receiving side apparatus can recognize a channel number of said low-speed frame signal”, as provided for in the context of the claims, as presented.

Since The “Utsumi” reference does not identically describe (or even suggest) the above-discussed features of the present claims, claim 1 (and its dependent claims 4 and 5) and claim 10 (and its dependent claims 13 and 14) are allowable.

Accordingly, claims 1, 4, 5, 10, 11, 12, 13 and 14 are allowable.

With respect to paragraph II of the Final Office Action, claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as unpatentable over the “Utsumi” reference in view of U.S. Patent No. 4,744,082 (“Fujimura”).

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claims 2 and 3 have been rewritten to include the allowable features (as indicated by the Examiner) of claim 7, which has been canceled without prejudice. Accordingly, claims 2 and 3 are allowable.

It is therefore respectfully submitted that claims 1 to 6, 8, 10 to 15, and 17 are allowable – like allowed claims 9 and 18.

Conclusion

It is therefore respectfully submitted that all of claims 1 to 6, 8, 10 to 15, and 17 are allowable -- like allowed claims 9 and 18. It is therefore respectfully requested that the objections and rejections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is therefore respectfully requested.

Respectfully submitted,

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